



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

ARNOLD & PORTER LLP
ATTN: IP DOCKETING DEPT.
555 TWELFTH STREET, N.W.
WASHINGTON DC 20004-1206

COPY MAILED

MAR 17 2006

OFFICE OF PETITIONS

In re Application of	:
Goto et al.	:
Application No. 08/915,004	: Decision on Petition for
Filed: August 20, 1997	: Patent Term Extension
Attorney Docket No. 16991.010	:
For: NOVEL PROTEINS AND METHODS	:
FOR PRODUCING THE PROTEINS	:

The above-identified application has been forwarded to the undersigned for consideration on the "Petition to the Commissioner," which was received on November 7, 2005, for the above-identified application. Petitioner argues that the patent should have an extension of 1,825 days due to delays in the Office for suspensions for a potential interference. See 35 U.S.C. § 154(b) and 37 C.F.R. § 1.701. Further requests or a request for reconsideration of this decision for patent term extension, must be filed under 37 CFR 1.182 or 37 CFR 1.183, and include the required fee.

The petition is dismissed.

Petitioner notes that the above-identified application was filed on August 20, 1997, allowed on September 7, 2005, but was delayed due to suspensions in prosecution for a potential interference. Petitioner states that the application was suspended from November 23, 1998 through September 7, 2005, therefore the patent should be extended by 1,825 days for the period of suspension. Petitioner states that the first suspension for a potential interference was mailed by the Office on November 23, 1998. Petitioner states that following the initial suspension, numerous status inquiry letters were submitted and that the application was suspended again for potential interferences on August 31, 1999, June 8, 2000 and March 21, 2001. Petitioner states that during this time numerous status inquiry letters were submitted and that a Petition to the Commissioner requesting information was submitted on June 13, 2003 and that a decision on December 16, 2003, stated that the application was still suspended for a potential interference. Petitioner states that after several more status inquiries, a Notice of Allowance was mailed on September 7, 2005. Petitioner argues that under 37 CFR 1.701(c)(1)(ii), the patent term should be extended the number of days in the period beginning on the date prosecution in the application was suspended by the PTO due to interference proceedings and ending on the date of the termination of the suspension. Petitioner argues that applicant is entitled to 1,825 days of patent term extension, not the 1,631 days of extension as stated in the Notice of Allowance.

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000.

35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these administrative delays and others in applications filed on or after May 29, 2000. The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Petitioner argues that under 37 CFR 1.701(c)(1)(ii), the patent term should be extended the number of days in the period beginning on the date prosecution in the application was suspended by the PTO due to interference proceedings and ending on the date of the termination of the suspension. While prosecution in the application was suspended, the suspension was due to a potential interference with applicant's application and another patent or application, not to await the result of interference in another application. As a result, the provisions of 37 CFR 1.701(a)(1) and (c)(1)(ii) do not apply. The provisions of 37 CFR 1.701(c)(1)(ii) apply to suspensions by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) and in this instance there were no interference proceedings. Both the statute and the rule require there to be "a proceeding under section 135(a)." Petitioner's argument that he is entitled to patent term extension for the period of suspension under 37 CFR 1.701(a)(1) is not persuasive.

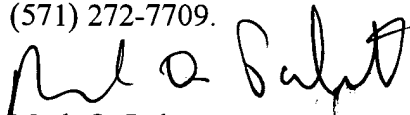
The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154. The delay in issuance of petitioner's application is regretted.

The Notice of Allowance and Issue Fee Due mailed September 7, 2005, incorrectly indicated that the patent to issue from the application 08/915,004 was eligible for a 1,631-day extension when no extension is due. The Office records have been corrected to indicate that the application is eligible for a 0-day extension.

After mailing of this decision, the above-identified application will be returned to Office of Publications for further processing. The patent, if issued, will include an indication that the patent term is extended by zero (0) days.

The petition fee (\$200) under 37 CFR 1.18(e) for filing an application for patent term adjustment has been refunded to Petitioner's Deposit Account No. 50-2387.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy